



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,144	09/20/2002	Frank F. Chang	56.0630	2763

27452 7590 04/07/2005

SCHLUMBERGER TECHNOLOGY CORPORATION
IP DEPT., WELL STIMULATION
110 SCHLUMBERGER DRIVE, MD1
SUGAR LAND, TX 77478

EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,144

Applicant(s)

CHANG ET AL

Examiner

Philip C. Tucker

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 9, 11-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 7, 8 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 4, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahayanake (6258859).

Dahayanake teaches a composition for treating subterranean formations which comprises a surfactant such as an alkylamidopropyl betaine and an acid (see abstract), wherein the surfactant is included in similar amounts (column 6, lines 22-30). The acid is present in amounts up to "about 10%", which is inclusive of greater than about 11%. Dahayanake teaches that the alkyl group may be erucyl (column 4, lines 1-6). Lower molecular weight alcohols, such as Isopropyl alcohol may be included in the fluid (column 8, lines 8-12). It would be obvious to one of ordinary skill in the art to utilize low molecular weight alcohols such as methanol or ethanol, since homologues of isopropyl alcohol with such similar structures would be expected to have similar utility.

Dahayanake differs from the present invention in that a specific example of the use of erucylamidopropyl betaine is not disclosed. It would however be obvious to one of ordinary skill in the art to utilize erucylamidopropyl betaine in the invention of Dahayanake, given the teaching of Dahayanake that that alkylamidopropyl betaines,

including the erucyl type, are useful in forming a composition for treating subterranean formations.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 9 and 10 of copending Application No. 10/231569. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claims of 10/231569 differ in the claimed range of acid, the scope of the ranges overlap, and the claims of 10/231569 would thus render the present claims obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1, 2, 4, 6, 9, 11-13 and 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 10, 12-20 and 23-26 of copending Application No. 10/191179. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claims of 10/191179 differ in that the acids are not specified, the use of either an organic or inorganic acid would be obvious to one of ordinary skill in the art in view of the general teaching of acid therein. Furthermore, the specification teaches the specific acids such as in claim 2. The current claims would thus be obvious to one of ordinary skill in the art over the claims of 10/191179.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 7, 8 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

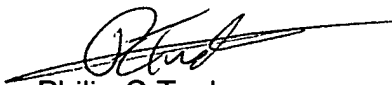
6. Claims 14 is allowable over the art of record.

7. Applicants amendment and arguments have been considered but are not deemed fully persuasive. Applicant's arguments with respect to Dahyanake are not deemed persuasive. The teaching of "about 10%" clearly encompasses the "greater than about 11%" of the current claims (In re DeVaney 88 USPQ 97, In re Ayers 69 USPQ 109). Furthermore, the utility of the term "lower molecular weight alcohol", along with specifically teaching isopropanol is seen to render the utility of ethanol and methanol obvious to one of ordinary skill in the art. Applicant has argued that the isopropanol is added for a different reason than in the present invention.. it is established that the reason for adding one material to another is not a patentable difference (In re Lintner 173 USPQ 356). Applicant has argued that the Hildebrand solubilities would distinguish the isopropanol from the ethanol and methanol of the present invention, but has given no experimental evidence that there is a distinguishing factor within the scope of the present invention. The rejection is thus maintained. New double patenting rejections are presented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3314